



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,048	07/29/2003	Eric Wensing	TJK/405	9283

27717 7590 11/02/2004

SEYFARTH SHAW  
55 EAST MONROE STREET  
SUITE 4200  
CHICAGO, IL 60603-5803

EXAMINER

NOVOSAD, CHRISTOPHER J

ART UNIT	PAPER NUMBER
----------	--------------

3671

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/631,048

Applicant(s)

WENSING, ERIC

Examiner

Christopher J. Novosad

Art Unit

3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In line 1 of claims 2-8, the recitation "A hole forming tool" should be corrected to --The hole forming tool-- since "A hole forming tool" has already been set forth in claim 1, line 1.

In claim 6, line 3, the recitation "can" renders the claim indefinite since it is unclear whether the gas emanates from the nozzle or not.

In claim 7, line 3, the recitation "blunt" is indefinite since "blunt" is a relative term.

In claim 7, line 3, the recitation "its" is indefinite since it is unclear as to what "its" is supposed to be.

Similarly, in claim 8, line 3, the recitation "it" is indefinite since it is unclear as to what "it" is supposed to be.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

Art Unit: 3671

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Zimmerman '408 in view of Nickell '905.

With respect to claim 1, Zimmerman '408 show a hole forming tool (Figs. 1-4) including:  
a hollow shroud 11 having a ground engaging portion 42 for engaging a soil surface 10;  
a fluid delivery means 23-25,30,12 including an outlet 23 disposed within the shroud 11;  
the outlet 23 being disposed at a position within the shroud 11 so that when the ground engaging portion 42 of the shroud 11 is driven into soil, fluid emanating from the outlet 23 disrupts the soil inside the shroud 11 to form a hole in the soil.

As to claim 2, the shroud 11 is a tube 11.

Regarding claim 3, the tube 11 is bent at a location (unnumbered) spaced from the ground engaging portion 42 to direct the disrupted soil away from the hole.

With respect to claim 5, the delivery means 23-25,30,12 includes a pipe 12 indirectly affixed to the inside (unnumbered) of the shroud 11.

As to claim 6, the outlet 23 is a nozzle 23 including more than one flow path 24,25 through which fluid can emanate from the nozzle 23.

Regarding claim 8, Zimmerman '408 shows a pair of handles 16,17 for grasping the tool (Figs. 1-4) to rotate the tool (Figs. 1-4) to drive it into soil.

The claims distinguish over Zimmerman '408 in requiring the fluid to be compressed gas.

Nickell '905 shows the use of compressed gas 116 as a fluid in a tool.

Art Unit: 3671

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized compressed gas as shown in Nickell '905 in place of the fluid of Zimmerman '408 for greater versatility and economy.

Alternatively, with respect to claim 1, Zimmerman '408 show a hole forming tool (Figs. 1-4) including:

a hollow shroud 31,32 having a ground engaging portion 32,52 for engaging a soil surface 10;

a fluid delivery means 23-25,30,12 including an outlet 23 disposed within the shroud 31,32;

the outlet 23 being disposed at a position within the shroud 31,32 so that when the ground engaging portion 32,52 of the shroud 31,32 is driven into soil, fluid emanating from the outlet 23 disrupts the soil inside the shroud 31,32 to form a hole in the soil.

With respect to claim 5, the delivery means 23-25,30,12 includes a pipe 12 indirectly affixed to the inside (unnumbered) of the shroud 31,32.

As to claim 6, the outlet 23 is a nozzle 23 including more than one flow path 24,25 through which fluid can emanate from the nozzle 24,25.

With respect to claim 7, the ground engaging portion 32,52 of the shroud 31,32 is provided with blunt serrations 52 spaced around its periphery.

Regarding claim 8, Zimmerman '408 shows a pair of handles 16,17 for grasping the tool (Figs. 1-4) to rotate the tool (Figs. 1-4) to drive it into soil.

The claims distinguish over Zimmerman '408 in requiring the fluid to be compressed gas.

Nickell '905 shows the use of compressed gas 116 as a fluid in a tool.

Art Unit: 3671

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized compressed gas as shown in Nickell '905 in place of the fluid of Zimmerman '408 for greater versatility and economy.

***Allowable Subject Matter***

Claim 4 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher J. Novosad whose telephone number is 703-308-2246. The examiner can normally be reached on Monday-Thursday 5:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Will can be reached at 703-308-3870. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3671

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Christopher J. Novosad  
Primary Examiner  
Art Unit 3671

November 1, 2004